

**REMARKS**

This reply is intended to be completely responsive to the Non-Final Office Action dated April 17, 2009.

**Status**

Claims 1-3, 8-16 and 27-41 are pending in this application, and claims 11 and 12 are withdrawn.

Claims 1-3, 8-10, 13-16 and 27-41 are rejected.

New claims 43 and 44 are added.

Applicant believes that each of the rejections raised by the Examiner have been addressed and the application is in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

**Claim Rejections – 35 U.S.C. § 102**

Rejection of claims 1-3, 8, 13-16, 27-33 and 36-41 under 35 U.S.C 102(b) as being anticipated by Harrington.

On pages 2-3 of the Office Action, the Examiner rejected claims 1-3, 8, 13-16, 27-33 and 36-41 under 35 U.S.C. 102(b) as being anticipated by Harrington, U.S. Patent No. 5,893,889. For the reasons set forth below, Applicant respectfully asserts that claims 1-3, 8, 13-16, 27-33 and 36-41 are not anticipated by Harrington.

Independent claims 1, 27, 30, 33 and 38

Independent claim 1 recites an “artificial disc prosthesis system ... wherein the stabilizing element may be removed from the cage through an opening created by removing at least one of the appendages.” Independent claim 27 recites an “artificial disc prosthesis system comprising

... a retaining means for removably retaining the stabilizing means when the artificial disc prosthesis system is disposed between two vertebrae.” Independent claim 30 recites an “artificial disc prosthesis system ... wherein the one or more appendages may be removed to provide an opening into or out of which the stabilizing element may be inserted or extracted.” Independent claim 33 recites an “artificial disc prosthesis system ... wherein the stabilizing element may be removed from the cage through an opening created by removing at least one of the appendages.” Independent claim 38 recites an “artificial disc prosthesis system ... wherein the stabilizing elements may be removed from the scaffold assembly through an opening created by removing at least one of the appendages.”

Harrington does not identically disclose an “artificial disc prosthesis system” as recited in each of independent claims 1, 27, 30, 33 and 38 including the elements highlighted in the previous paragraph. In contrast, Harrington discloses a “prosthesis disc 18” that includes a “tubular membrane 78” (identified as the appendage by the Examiner) and an “annular shock absorbing member 68” (identified as the stabilizing element by the Examiner) that extends “around the post 45.” See col. 3, lines 58-60, col. 4, lines 15-17, and Fig. 2. As can be seen from this arrangement, removal of the “annular shock absorbing member 68” from between “upper member 32” and “lower member 34” would require substantial disassembly of “prosthesis disc 18” including disconnection of “post 45” from “lower member 34.” See Fig. 2. Thus, detaching “tubular membrane 78” from “prosthesis disc 18” does not create an opening through which “annular shock absorbing member 68” may be removed.

As such, Harrington does not identically disclose an “artificial disc prosthesis system ... wherein the stabilizing element may be removed from the cage through an opening created by removing at least one of the appendages,” as recited in independent claim 1, an “artificial disc prosthesis system ... comprising ... a retaining means for removably retaining the stabilizing means when the artificial disc prosthesis system is disposed between two vertebrae,” as recited in independent claim 27, an “artificial disc prosthesis system ... wherein the one or more appendages may be removed to provide an opening into or out of which the stabilizing element

may be inserted or extracted,” as recited in independent claim 30, an “artificial disc prosthesis system ... wherein the stabilizing element may be removed from the cage through an opening created by removing at least one of the appendages,” as recited in independent claim 33, or an “artificial disc prosthesis system ... wherein the stabilizing elements may be removed from the scaffold assembly through an opening created by removing at least one of the appendages,” as recited in independent claim 38.

Accordingly, Applicant respectfully asserts that independent claims 1, 27, 30, 33 and 38 and corresponding dependent claims 2, 3, 8, 13-16, 28-33, 36, 37 and 39-41 are not anticipated by Harrington.

Dependent claims 3, 16, 32, 37 and 40

Dependent claims 3, 16, 32, 37 and 40 each recite a “fusion prosthesis.” Harrington does not identically disclose a “fusion prosthesis” as recited in claims 3, 16, 32, 37 and 40. Harrington discloses a “prosthesis disc 18.” See col. 2, line 66. Further, the Examiner cites column 4, lines 13-31 as disclosing a “fusion prosthesis.” Office Action page 3. The cited portion of Harrington relates to the assembly and installation of “prosthesis disc 18” and does not disclose a “fusion prosthesis.” Accordingly, Applicant respectfully asserts that claims 3, 16, 32, 37 and 40 are further patentable over Harrington.

Dependent claim 29

Dependent claim 29, which depends from independent claim 1, recites “wherein the first and second bases are ring-shaped.” Harrington discloses a “prosthesis disc 18” that includes an “upper member 32” that has “a generally disc shaped base portion 49” and a “lower member 34” that has a “frustoconically shaped upper surface 44.” See col. 3, lines 11-13, lines 22-23, and lines 30-31. However, Harrington does not disclose a disc prosthesis where “the first and second bases are ring-shaped,” as recited in claim 29. Accordingly, Applicant respectfully asserts that claim 29 is further patentable over Harrington.

**Claim Rejections – 35 U.S.C. § 103**

**Rejection of claims 9 and 10 under 35 U.S.C. 103(a) as being unpatentable over Harrington in view of Parsons et al.**

On page 3 of the Office Action, the Examiner rejected claims 9 and 10 under 35 U.S.C. 103(a) as being unpatentable over Harrington in view of Parsons et al., U.S. Patent No. 5,545,229. For the reasons set forth below, Applicant respectfully asserts that claims 9 and 10 are allowable under 35 U.S.C. § 103(a).

As discussed above Harrington does not disclose, teach, or suggest an “artificial disc prosthesis system ... wherein the stabilizing element may be removed from the cage through an opening created by removing at least one of the appendages” as recited in independent claim 1. Parsons et al. does not remedy the deficiencies of Harrington. Parsons et al. discloses an “intervertebral spacer” including a “central core 2,” an “outer ring 4 of stiffer elastomeric material surrounding said central core,” and “endplates 8 and 10 ... affixed, one to each end, to the outer ring/central core.” See col. 4, lines 7-15. However, Parsons et al. does not appear to disclose, teach, or suggest, “artificial disc prosthesis system ... wherein the stabilizing element may be removed from the cage through an opening created by removing at least one of the appendages” as recited in independent claim 1.

Accordingly, dependent claims 9 and 10, that depend from independent claim 1, would not have been obvious over Harrington in view of Parsons et al. under 35 U.S.C. § 103(a).

**Rejection of claims 34 and 35 under 35 U.S.C. 103(a) as being unpatentable over Harrington in view of Baumgartner**

On page 4 of the Office Action, the Examiner rejected claims 34 and 35 under 35 U.S.C. 103(a) as being unpatentable over Harrington in view of Baumgartner, U.S. Patent No. 5,370,697. For the reasons set forth below, Applicant respectfully asserts that claims 34 and 35 are allowable under 35 U.S.C. § 103(a).

For the same reasons as discussed above, Harrington does not disclose, teach, or suggest an “artificial disc prosthesis system ... wherein the stabilizing element may be removed from the cage through an opening created by removing at least one of the appendages,” as recited in independent claim 33. Baumgartner does not remedy the deficiencies of Harrington. Baumgartner discloses an “intervertebral disk member 1” having “reinforced edge parts 16” and “stops 17.” However, Baumgartner does not appear to disclose, teach, or suggest, an “artificial disc prosthesis system ... wherein the stabilizing element may be removed from the cage through an opening created by removing at least one of the appendages,” as recited in independent claim 33.

Accordingly, dependent claims 34 and 35, that depend from independent claim 33, would not have been obvious over Harrington in view of Baumgartner under 35 U.S.C. § 103(a).

### **New Claims**

Applicant has added new claims 43 and 44 to present claims of varying scope. New claims 43 and 44 depend from independent claim 1. No new matter has been added. Applicant respectfully asserts that new claims 43 and 44 are patentable for at least the same reasons set forth regarding independent claim 1 and present new elements not disclosed by the cited references. Applicant respectfully requests allowance of new claims 43 and 44.

### **Conclusion**

Claims 1-3, 8-10, 13-16 and 27-41 are pending in the present application. New dependent claims 43 and 44 have been added. Applicant believes that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

It should be noted that, for the sake of clarity and simplicity, Applicant's remarks have focused on the rejections of the independent claims and certain dependent claims set forth in the Office Action with the understanding that the dependent claims are patentable for at least the same reasons as the independent claims. Further, in addressing the Examiner's rejections, Applicant's remarks have set forth only some of the available arguments for patentability of the rejected claims. Applicant expressly reserves the right to argue the patentability of all claims separately and to provide new, different, or additional arguments for patentability not set forth herein, including, but not limited to, the failure of cited references to disclose, teach, or suggest other elements of the claims, the lack of motivation to combine cited references, or teaching away from the combination of cited references, in this or any future proceedings.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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